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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,522	04/27/2006	Peter Hoghoj	7875-012	6829
20575 7590 09/02/2010 MARGER JOHNSON & MCCOLLOM, P.C. 210 SW MORRISON STREET, SUITE 400 PORTLAND, OR 97204				
EXAMINER				
THROWER, LARRY W				
ART UNIT		PAPER NUMBER		
1791				
NOTIFICATION DATE		DELIVERY MODE		
09/02/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@techlaw.com

Office Action Summary

Application No.

10/577,522

Applicant(s)

HOGHOJ ET AL.

Examiner

LARRY THROWER

Art Unit

1791

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-18 and 30-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-18 and 30-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 19, 2010 has been entered.
2. Claims 1-7 and 19-29 are canceled; claims 8, 13-14 and 32-33 are amended. Claims 8-18 and 30-35 are under examination.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 8, 12 and 30-35** are under 35 U.S.C. 103(a) as being unpatentable over Richards (US 5,855,966) in view of Economy et al. (US 4,515,828).
- Regarding **claim 8**, Richards discloses a replication method for producing a smooth object having a low surface roughness (abstract). The method includes producing a replication master (10) by forming the master to have a desired external surface shape which at least partially corresponds to a counterform of a surface of an object

to be produced by replication (col. 2, lines 36-45), treating the external surface of the master to obtain a predetermined surface roughness value (col. 2, lines 46-55), and coating at least a part of the master with a smoothening layer made of a soluble material having a flowability such that the top surface of the smoothening layer displays a smaller roughness than the surface on which it is formed (col. 2, line 56 - col. 3, line 11); coating at least a part of the master with an object material such that the surface of the object corresponds to a counterform of the master (col. 4, lines 33-38); and releasing the object from the master (col. 4, lines 33-38).

- Richards is silent as to the smoothening layer being made of a polymer. However, Economy et al. discloses a replication method for producing a smooth object having a low surface roughness (abstract), which includes producing a replication master by forming the master to have a desired external surface shape which at least partially corresponds to a counterform of a surface of an object to be produced by replication (col. 2, lines 60-66), and coating at least a part of the master with a smoothening layer made of a soluble polymer material having a flowability such that the top surface of the smoothening layer displays a smaller roughness than the surface on which it is formed (col. 2, lines 60-68); and coating at least a part of the master with an object material such that the surface of the object corresponds to a counterform of the master (col. 3, lines 1-9). As taught by Economy et al., coating the master with a smoothening layer made of a polymer effectively reduces the surface roughness of the master (col. 3, lines 15-36) and allows a variety of smooth objects to be produced (col. 3, lines 1-9). Thus, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to have utilized the polymer of Economy et al. in the replication method of Richards for the surface roughness reduction effect, as taught by Economy et al.

- Regarding **claim 12**, Richards discloses the object being an optical device (col. 4, lines 33-38).
- Regarding **claim 30**, Economy et al. discloses the smoothening layer being applied by spin coating the master with a liquid smoothening material and hardening the smoothening material (col. 3, lines 15-35).
- Regarding **claims 31-34**, Richards discloses coating a thin metallic layer on top of or under the smoothening layer (col. 4, lines 1-22).
- Regarding **claim 35**, Richards discloses the smoothening layer having a roughness of about 50 Angstroms, but is silent as to the roughness being 5 Angstroms or less. However, absent evidence of unexpected results obtained from obtaining the claimed roughness, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have achieved a suitable surface roughness to effectively mold optical elements and allow a variety of smooth objects to be produced as taught by Economy et al. (col. 3, lines 1-9), the surface roughness being a result effective variable routinely optimized by those of skill in the art, as recognized by Richards (col. 1, lines 33-42) and Economy et al. (col. 3, lines 30-36). The optimization of a range or other variable within the claims that flows from the "normal desire of scientists or artisans to improve upon what is already generally known" is *prima facie* obvious. *In re Peterson*, 315 F.3d 1325, 1330 (Fed. Cir. 2003).

5. **Claims 9-11 and 15-18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Richards (US 5,855,966) in view of Economy et al. (US 4,515,828), as applied to claim 8 above, in view of Hallman et al. (US 5,505,808).

- Regarding **claim 9**, Richards is silent as to dissolving the smoothening layer or a release layer with a solvent. However, Hallman et al. discloses a method of releasing an object from a master which includes dissolving a releasing layer on top of the master with a solvent (col. 5, lines 9-21). As taught by Hallman et al., dissolving a releasing layer which holds an object to a master with a solvent effectively releases the object from the master. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have dissolved the smoothening or releasing layer of Richards with a solvent because, as taught by Hallman et al., this effectively releases the object from the master (col. 5, lines 9-21).
- Regarding **claims 10-11**, Hallman et al. discloses gluing an object support to an object, which inherently fills the gaps between the two (col. 4, line 63 - col. 5, line 8).
- Regarding **claims 15-17**, Hallman et al. discloses the object and glue including epoxy (col. 7, lines 35-54).
- Regarding **claim 18**, Hallman et al. discloses coating the master with a protection layer on top of the smoothening layer (col. 7, lines 35-54).

6. **Claims 13-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Richards (US 5,855,966) in view of Economy et al. (US 4,515,828), as applied to claim 8 above, in view of Meeks (US 2002/0145740).

- Richards is silent as to characterizing the optical device by profilometry or reflectometry measurement. However, Meeks discloses a method of characterizing an optical device by profilometry (abstract). As taught by Meeks, characterizing a device by optical profilometry enables topographic and non-topographic defects to be detected (§§5 and 8). Thus, it would have been obvious to one of ordinary skill in the art to have measured the optical profile of the object produced in the method of Richards with the optical profilometer of Meeks in order to detect defects in the optical device to prevent failure of the optical device, as taught by Meeks (§5).

Response to Arguments

7. Applicant's arguments filed August 19, 2010 have been fully considered but they are not persuasive.

- Applicant argues that "Economy et al. does not propose that the planarization layer, after being formed on the respective surface, should still be soluble in order to be removable from time to time." (emphasis added). This argument has been considered but is not persuasive because it is not commensurate in scope with the instant claims. Claim 8 only requires the smoothening layer to be soluble after being formed on the master. There is no requirement that the layer be removable. Col. 2, lines 13-44 of Economy et al. discloses that a prepolymer material is formed on the

master in the form of a solution. Thus, the material is soluble after being formed on the master, which is no less than is required by the instant claims.

- Applicant further argues that Economy et al. fails to disclose releasing the object from the master. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The rejection is based on the combination of Richards in view of Economy et al., where Richards discloses a replication method for producing a smooth object having a low surface roughness (abstract). The method includes producing a replication master (10) by forming the master to have a desired external surface shape which at least partially corresponds to a counterform of a surface of an object to be produced by replication (col. 2, lines 36-45), treating the external surface of the master to obtain a predetermined surface roughness value (col. 2, lines 46-55), and coating at least a part of the master with a smoothening layer made of a soluble material having a flowability such that the top surface of the smoothening layer displays a smaller roughness than the surface on which it is formed (col. 2, line 56 - col. 3, line 11); coating at least a part of the master with an object material such that the surface of the object corresponds to a counterform of the master (col. 4, lines 33-38); **and releasing the object from the master** (col. 4, lines 33-38). Richards is silent as to the smoothening layer being made of a polymer. However, Economy et al. discloses a replication method for producing a

smooth object having a low surface roughness (abstract), which includes producing a replication master by forming the master to have a desired external surface shape which at least partially corresponds to a counterform of a surface of an object to be produced by replication (col. 2, lines 60-66), and coating at least a part of the master with a smoothening layer made of a soluble polymer material having a flowability such that the top surface of the smoothening layer displays a smaller roughness than the surface on which it is formed (col. 2, lines 60-68); and coating at least a part of the master with an object material such that the surface of the object corresponds to a counterform of the master (col. 3, lines 1-9). As taught by Economy et al., coating the master with a smoothening layer made of a polymer effectively reduces the surface roughness of the master (col. 3, lines 15-36) and allows a variety of smooth objects to be produced (col. 3, lines 1-9). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized the polymer of Economy et al. in the replication method of Richards for the surface roughness reduction effect, as taught by Economy et al.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LARRY THROWER whose telephone number is 571-270-5517. The examiner can normally be reached on Monday through Friday from 9:30AM-6PM est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina A. Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Larry Thrower/
Examiner, Art Unit 1791

/Christina Johnson/
Supervisory Patent Examiner, Art Unit 1791